

## REMARKS

Claims 1-7, 9, and 11 are pending in the application. The Examiner has rejected claims 1-7, 9, and 11. Claim 1 has been amended. Original claims 2-6 have been resubmitted as claims 12-21, and include the proposed amendments discussed with the Examiner in the telephonic interview. No new matter was added with these changes.

### **Specification Objections**

The Examiner has objected to the disclosure because "page 10, lines 105 indicate item (20) as a mark-retaining surface and a base element at the same time." The disclosure has been amended to correct this typographic error. As seen in numerous places in the disclosure, the base element should have been associated with reference number 12. Applicant respectfully requests withdrawal of this rejection.

The Examiner has objected to disclosure, stating that "[p]age 10, lines 1-11 discloses that the NCR paper (20) is to be secured to the sheet of the durable resilient material (18) but not to the base (12) as shown on Fig. 4." Office Action, page 2. Applicant respectfully requests reconsideration of this objection in light of the following remarks. The base element 12, as referred to in the specification, for example in the Summary on page 5, represents the base element, of which the sheet 18 and the rubber mat 14 are a part. Thus, securing the NCR paper to the durable sheet 18 does disclose securing the NCR paper to the base element 12. Applicant requests reconsideration of the objection in light of the foregoing comments.

The Examiner has objected to the drawings the drawings as "failing to comply with 37 CFR 1.84(p)(4) because reference characters "12" and "14" have both been used to designate a base and a rubber mat." Applicant respectfully traverses this objection. As discussed above, the base element 12, as referred to in the specification, for example in the Summary on page 5, represents the base element of which the sheet 18 and the rubber mat 14 are a part.

Thus, there is no error in the drawing references with regard to the specification, and no amendment to the drawings is required. Applicant respectfully requests reconsideration of this objection in light of the foregoing comments.

### **Claim Rejections – 35 USC § 112**

The Examiner has stated that “[c]laims 1, 7, 9, and 11 are indefinite because claim 2 recites the limitation “said firm support layer” in line 6.” Claim 1 has been amended and now provides the antecedent basis for this limitation. Applicant requests withdrawal of this rejection.

### **Summary of Telephonic Interview**

A telephonic interview was held between Examiner Nini F. Legesse and Applicant’s Attorney Michael A. Guth on April 7, 2004. Applicant thanks the Examiner for this helpful interview.

Attorney Guth had provided an informal proposed amendment to the Examiner prior to the telephonic interview. Attorney Guth stressed that the goal of the proposed amendments was to modify the claims in light of the Examiner’s rejections in order to facilitate the quicker allowance of some claims, a goal of applicant in light of the length of time of the prosecution of this application to date. Attorney Guth stressed that this narrowing of claims was not a concession to the Examiner’s rejections, which would be argued. Attorney Guth stated that if these narrower claims were allowed, and the unmodified claims were not allowed in light of the arguments in this response, then the unmodified claims would be cancelled from this application and further pursued in a continuation application.

The proposed amendments centered on further limitation to claim 2, which also affects claims 3-6 which are dependent claims of claim 2. The first proposed amendment discussed was the addition of a limitation to claim to "wherein the mark retaining surface means is easily removable and replaceable." Attorney Guth pointed out that the layer 112 of reference Perrine was not easily removable and replaceable. Examiner Legesse responded that the disclosed wax on the top surface of layer 112 would also be easily removable and replaceable. Attorney Guth pointed out how the removal of the wax would also destroy any record of the mark, and that this differs substantially from the present invention. Attorney Guth then proposed the further limitation of "and wherein the removed portion retains the marking." Examiner Legesse indicated that she would look favorably upon such an amendment, but did not commit to allowance and requested to see the amendments formally.

The second of the proposed amendment also involved a further limitation to claim 2. The limitation to claim to was "wherein said firm support layer is significantly more rigid than the mark retaining layer." Attorney Guth pointed out that the two layers 112, 150 in Perrine referred to by the Examiner in the rejection were disclosed as being of the same material and rigidity. Attorney Guth pointed out that in the present invention that the rigid support layer is substantially more rigid, as wood and polycarbonate plastic are disclosed.

Examiner Legesse also mentioned that she would prefer that the claim modifications refer to structure and not use.

In summary, the interview did not conclude with an agreement for allowance based on the proposed amendments, but Examiner did, in Attorney Guth's opinion, indicate that she would look favorably on the first proposed amendment with the further discussed limitation regarding the retention of the marking.

## New Claims 12-16

New claims 12-16 have been added. Claim 12 represents the modified claim 2, where the modifications are based upon the discussion of the telephonic interview as summarized above. In order to comply with the Examiner's suggestion that structure and not use be highlighted, the discussed proposed amendment of "wherein said mark retaining surface means is easily removed and replaced" has been changed to "wherein said mark retaining means is adapted to be easily removed and replaced". Similarly, the discussed limitation of "and wherein the removed portion retains the marking" has been changed to "wherein said mark retaining means is adapted to retain marks after removal."

New claims 12-16 have been added to reflect further limitations to claims 2-6, as discussed in the telephonic interview. Applicant does not concede to the Examiner's rejection of claim 2, which is argued below. Applicant's goal with regard to the further limitations expressed in claim 12 is to facilitate allowance of some claims, and then to, if necessary, pursue the current claims in a continuing application.

Applicant asserts that claim 12, and its dependant claims 13-16 are allowable for the reasons discussed in the telephonic interview, and are restated below.

*Perrine's* layer 112 in Figure 6, like its layer 12 in Figure 1, is not meant to be easily removed. It is disclosed as being attached by screws (Col. 5, ln 34) for the layer 12 and, for the 112, "a strip 150 ... may be thermally or adhesively bonded to the under surface of the top sheet 112". In *Perrine*, the top sheet 112, like the layer 12, is not disclosed as coming off of the base 114 after assembly. And the strip 150 is bonded up into the top sheet; it appears to be permanently attached to the top sheet (note thermal bond reference, Col. 6, ln 55) which itself is not easily removable. Nowhere does *Perrine* disclose easy removal, of the "mark

retaining surface means”, for example for later comparison to other such sheets. The present invention, as seen in the Figures, and as described on page 10, lines 21-23, allows for such removal and later comparison. Also the present application discloses the attachment of the “mark retaining surface means” using hook and loop fastening elements (Velcro), understood to be easily removable. Thus, *Perrine* does not disclose a mark retaining surface, “wherein said mark retaining surface means is adapted to be easily removed and replaced, and wherein said mark retaining means is adapted to retain marks after removal”, as recited in claim 12.

For the foregoing reasons, Applicant respectfully requests allowance of claim 12, and its dependent claims 13-16.

#### **New Claims 17-21**

New claims 17-21 have been added. Claim 17 represents claim 2 with the further limitations of claim 12, and the further limitations of the second proposed amendment, as discussed with the Examiner during the telephonic interview.

Claim 17 adds the limitation of “wherein said firm support layer is significantly more rigid than said mark retaining layer.” In *Perrine*, the layer 150, used by the Examiner to illustrate the firm support layer, and the layer 112, used by the Examiner to illustrate the mark retaining surface means, are the same material/rigidity (*Perrine*, Col. 6, Ins. 54-59), yet are disclosed as very different in the present invention (plastic or wood vs. paper, for example). Thus, claim 17 is allowable over the prior art for at least this additional reason.

Applicant respectfully requests allowance of claim 17 and its dependent claims 18-21.

## Claim Rejections – 35 USC § 102

The applicant has incorporated the proposed amendments into claims 12-16, and 17-21 as discussed above, and now argues the rejections of the current claims below.

The Examiner has rejected claim 1 “under 35 U.S.C. 102(b) as being anticipated by Perrine (US Patent No. 5,984,802).”

The Examiner has rejected claim 2 “under 35 U.S.C. 102(b) as being anticipated by Perrine (US Patent No. 5,984,802).” Applicant respectfully traverses this rejection.

Arguments with regard to claims 1 and 2 are as follow:

The Examiner states that the firm support layer is disclosed by item 150 in *Perrine*.

*Perrine* discloses:

The top sheet 112 is made from one of the smooth, low-friction, tough, flexible types of plastic material used for the preceding embodiments, but, because it can now be wrapped around, and fastened to the added bottom sheet 117, it can be a **thinner gauge, and thus even more compliant**. For example, the top sheet 112 can be made from a 30cm (12 in) wide, **0.051 cm (0.020 in) thick** sheet of Estane 58277, having a **rigidity of only about 0.0005 MPa (0.07 psi)**.

**A strip 150 of the same or chemically compatible, plastic material, with a similar thickness and length, and a width on the ....**

*Perrine*, Col. 6, lines 45-56, emphasis added

The layer 150 of *Perrine* referred to by the Examiner is a very thin, very soft layer.

Thus, *Perrine* does not disclose a “firm support layer” as recited in claims 1 and 2.

The Examiner has rejected claims 4 and 5 “under 35 U.S.C. 102(b) as being anticipated by *Perrine*. Applicant requests withdrawal of this rejection for at least the reason of their dependency on claim 2, discussed above.

The Examiner has rejected claim 11 “under 35 U.S.C. 102(b) as being anticipated by Perrine. Claim 11 is allowable for at least the reasons above with regard to claim 1, upon which it depends. Applicant requests withdrawal of this rejection.

### **Claim Rejections – 35 USC § 103**

The Examiner rejected claim 3 “under 35 U.S.C. 103(a) as being unpatentable over Perrine.” Office Action, page 5. Applicant traverses this rejection. Claim 3 is allowable for at least the reason of its dependence on claim 2, whose merits were argued above. Applicant requests withdrawal of this rejection.

The Examiner rejected claim 6 “under 35 U.S.C. 103(a) as being unpatentable over Perrine.” Office Action, page 5. Applicant traverses this rejection. Claim 6 is allowable for at least the reason of its dependence on claim 2, whose merits were argued above. Applicant requests withdrawal of this rejection.

The Examiner rejected claim 7 “under 35 U.S.C. 103(a) as being unpatentable over Perrine in view of Manheck (US patent No. 3,754,764).” Office Action, page 6. Applicant traverses this rejection. Claim 7 is allowable for at least the reason of its dependence on claim 2, whose merits were argued above.

In addition, *Manheck* is directed to “providing an effective means for capturing the exact impact point of a golf ball on the face of a club, thereby permitting an instant, visual evaluation of where the club hits the ball immediately after each swing.” *Manheck*, Col. 1, lns. 40-45. This use contrasts with the invention of the present application in many ways. First, it involves the strike of the club to the ball, and not the strike of the club to the ground as in the present invention. *Manheck* requires using a golf ball, which the present invention does not. Second, it involves a modification to the golf club. Third, any multiple use of the

sheet 24 of *Manheck* will involve distorting earlier marks. These points stand in stark contrast to “a sheet of no carbon required paper having one or more simulated golf balls printed thereon”, as recited in claim 7. Each of the simulated golf balls allows for the recording of a different swing with only the slight relocation of the golfer’s body to address a new position. Applicant asserts that these stark differences of end use and method of use discount any possibility of motivation to combine these references, as well as the fact that nowhere is taught or suggested a “sheet of no carbon required paper having one or more simulated golf balls printed thereon”, as recited in claim 7, in either of the references. Applicant asserts that claim patentable for at least the foregoing reasons. Applicant requests withdrawal of this rejection.

The Examiner rejected claim 9 “under 35 U.S.C. 103(a) as being unpatentable over Perrine in view of Grossman (US patent No. 2,660,436).” Office Action, page 6. Applicant traverses this rejection. Claim 9 is allowable for at least the reasons of its dependence on claim 1, whose merits were argued above, and for substantially the same reasons a discussed above with regard to claim 7.

The Examiner rejected claim 2 “under 35 U.S.C. 103(a) as being unpatentable over Perrine in view of Miller (US patent No. 5,028,052).” Office Action, page 7. Applicant strenuously traverses this rejection.

The Examiner has stated that “[i]t would be obvious to one of ordinary skill in the art at the time of the invention was made to provide different arrangement of golf mat components as taught by Miller in the Perrine’s device in order to provide the feel of natural turf as the club head strikes a golf ball placed on hitting surface.” Office Action, page 8. The Examiner has ascribed a purpose (to provide the feel of natural turf) to the present invention that is not stated in the specification, nor has the Examiner given any basis for having ascribed



such a purpose. Because the Examiner has ascribed this unstated purpose to the present invention, the Examiner then sees motivation to combine the stated references. Applicant asserts that this ascription of purpose is in error, and therefore cannot respond to the rejection. Applicant requests withdrawal of this rejection.

#### **Summary**

Applicant again thanks the Examiner for the helpful telephonic interview on April 7, 2004. Applicant believes that all claims are in a condition for allowance and requests allowance of all claims. Should the Examiner have any questions concerning this response, the Examiner is invited to contact the undersigned at (831) 462-8270.

Yours Sincerely,



Michael A. Guth

Registration No. 45, 983